

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

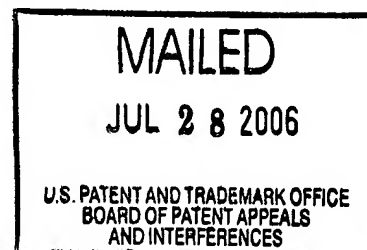
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KURT PLOTZ

Appeal No. 2006-1392
Application No. 10/619,609¹

ON BRIEF



Before PAK, WALTZ, and KRATZ, Administrative Patent Judges.

PAK, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's refusal to allow claims 1, 3 through 11, 13 through 16, and 32 through 34, which are all of the claims pending in the above-identified application. We have jurisdiction pursuant to 35 U.S.C. § 134.

¹ Application for patent filed July 16, 2003.

APPEALED SUBJECT MATTER

Claims 1 and 34 are representative of the subject matter on appeal and read as follows:

1. Wall and floor coverings based on a carrier coated with one or more layers, said carrier consisting essentially of:

a fiberglass containing mat pre-consolidated with a binder, and

a non-woven mat made of thermally fixed organic synthetic fibers bound with said fiberglass mat by needling, wherein part of said organic fibers penetrate through said fiberglass mat and lie adjacent to a side of said fiberglass containing mat that is opposite to said organic non-woven mat; and

one or more layers coated on a glass fiber side of said carrier, opposite the non-woven synthetic mat.

34. Wall and floor coverings comprising a carrier coated with one or more layers, said carrier consisting essentially of:

a glass fiber-containing mat pre-consolidated with a binder; and

a non-woven mat comprised of thermally fixed organic synthetic fibers bonded to said fiberglass mat by hydrodynamic needling, wherein part of said organic fibers penetrate through said glass fiber mat and lie adjacent to a side of said glass fiber-containing mat that is opposite to said organic fiber non-woven; and

at least one layer bonded to a glass fiber of said carrier, opposite the non-woven synthetic mat.

REFERENCE

The prior art references relied upon by the examiner in support of the § 103 rejections before us are²:

Hiers (Hiers '876)	4,522,876	Jun. 11, 1985
Frankenburg et al. (Frank)	4,569,088	Feb. 11, 1986
Greiser et al. (Greiser)	5,017,426	May 21, 1991 ³
Heidel et al. (Heidel)	5,171,629	Dec. 15, 1992
Baravian et al. (Baravian)	5,616,395	Apr. 1, 1997
Hiers et al. (Hiers '622)	6,092,622	Jul. 25, 2000

REJECTIONS

The appealed claims stand rejected as follows:

- 1) Claims 1, 4, 5, 9, 10 and 15 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Greiser and Hiers '622;
- 2) Claims 1, 3 through 5, 9 through 11, 15, 16 and 32 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Baravian, Hiers '622 and Heidel;

2 The examiner does not list the Heidel reference in the Prior Art of Record section even though it is relied upon in one of the rejections set forth in the Answer.

3 The examiner inadvertently causes confusion by assigning two different patent numbers to Greiser, i.e., "4,522,876" in the Prior Art of Record section and "5,017,426" in the Ground of Rejection section. The U.S. patent number "4,522,876" belongs to Hiers '876.

- 3) Claim 13 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Baravian, Hiers '622 and Hiers '876;
- 4) Claims 6 through 8, 14 and 33 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Baravian, Hiers '622, and Heidel⁴;
- 5) Claim 34 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Baravian, Hiers '622, and Frank; and
- 6) Claims 1, 4, 5, 9, 10 and 15 under the judicially-created doctrine of obviousness-type double patenting as unpatentable over claims of 1 through 6 of Greiser in view of Hiers '876.

OPINION

We have carefully reviewed the claims, specification and prior art, including all of the arguments advanced by both the examiner and the appellants in support of their respective positions. As result of this review, we have made the determinations which follow.

As evidence of obviousness of the claimed subject matter under § 103, the examiner relies on Greiser or Baravian to teach a laminate useful for roofing and sealing. See the Answer, pages

⁴ Although the statement of rejection set forth by the examiner is confusing as to which Hiers is relied upon to reject claims 6 through 8, 14 and 33, we will presume that the examiner is relying on Hiers '622 since the body of the rejection refers to "Hiers et al".

3 and 4. According to the examiner (e.g., the Answer 3), these references do not teach "one or more layers coated on a glass fiber side of the carrier."

To remedy this and other deficiencies, the examiner relies on the disclosure of Hiers '622. However, as correctly pointed out by the appellant (the Brief, page 6), Hiers '622 is directed to "thermal and acoustical insulating laminates designed primarily for automotive uses..." rather than for roofing or sealing uses. See also Hiers '622, column 1, lines 4-45. The examiner has not adequately explained why one of ordinary skill in the art would have been led to employ one or more additional coating from the laminates taught by Hiers '622 on the glass fiber side of Greiser's or Baravian's roofing or sealing laminate. See the Answer in its entirety. Thus, we concur with the appellant that the examiner has not demonstrated that one of ordinary skill in the art seeking to improve the roofing or sealing sheets would look to the laminates of Hiers '622 to coat one or more layers on the glass fiber side thereof.

Accordingly, we reverse the § 103 rejections and the obviousness double patenting rejection as proposed by the examiner and recommend consideration of the following matters.

OTHER ISSUES

We observe that Greiser teaches a laminate "suitable as a carrier web for roofing and sealing sheets comprises a preconsolidated synthetic fiber web and preconsolidated mineral fiber web which are bonded to each other by needling." See column 1, lines 48-52. Greiser teaches that "[p]referred mineral fiber webs are glass fiber webs..." See column 1, line 66. These "roofing and sealing sheets are usually coated with bitumen on one or both sides, but can also have a coating made from elastomers or plastomers," thus meeting the claimed requirement for one or more layers coated on a glass fiber side of the carrier web. See column 1, lines 10-15.

The dispositive question raised is, therefore, whether Greiser teaches or would have suggested "part of said organic synthetic fibers penetrate through said fiberglass mat and lie adjacent to a side of said fiberglass containing mat that is opposite to said organic non-woven mat" recited in claim 1. On this record, we answer this question in the affirmative.

Greiser teaches (column 2, lines 13-22):

The needling should comprise 10 to 100 stitches/cm², preferably between 20 and 50 stitches/cm². This needling is carried out in such a way that the needles first enter the synthetic fiber web and then penetrate through the material fiber web underneath. The depth of a stitch naturally depends on the thickness of the

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webs. It is between 6 and 11 mm and leads to a strong positive join of the synthetic fiber web to the mineral fiber web by means of **synthetic fibers pulled through the latter**. Emphasis added.

Moreover, we note that in an exemplified embodiment⁵ in a related Application 09619536, needling the synthetic and mineral fiber webs at 32 stitches/cm², which is within the preferred stitch range taught in Greiser, is said to provide the claimed penetration characteristics. Thus, absent any evidence to the contrary, it is reasonable to infer that Greiser necessarily describes "part of said organic synthetic fibers penetrate through said fiberglass mat and lie adjacent to a side of said fiberglass containing mat that is opposite to said organic non-woven mat" as recited in claim 1. Thus, we determine that Greiser describes or would have suggested at least the subject matter as recited in claim 1 within the meaning § 102(b) or 103(a).


Upon return of this application, the examiner is advised to determine whether Greiser affects the patentability of the remaining claims.

⁵ The appellant did not disclose this embodiment in the subject application.

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This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) is not made for further consideration of a rejection. Accordingly, 37 CFR § 41.50(a)(2) does not apply.

REVERSED AND REMANDED


CHUNG K. PAK

CHUNG/K. PAK
Administrative Patent Judge

THOMAS A. WALTZ

THOMAS A. WALTZ
Administrative Patent Judge

Pety. F. Kuro

PETER F. KRATZ
Administrative Patent Judge

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INTERFERENCES

CKP : TF

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